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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,078	07/19/2001	Akira Taguchi	4196-A2JPUS	9893
29370	7590	07/20/2004		
ROBERT A. PARSONS 340 E. PALM LN SUITE 260 PHOENIX, AZ 85004			EXAMINER MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/909,078

Applicant(s)

TAGUCHI, AKIRA

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that the book "is printed and delivered via telecommunication line". It is not clear how the book is delivered via telecommunications lines since as understood by the examiner, the invention contemplates physical printing.

Claims 1, 4 and 5 are unclear because is not clear who is acting in the "inputting predetermined items" step, the "going to a home page of ... binding vendor"; and "inputting items that specify the name and address ... payment method." It is assumed that the customer is acting in these steps.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by the Ebookstand website.

Ebookstand shows displaying a list of books on a recommendation home page (e.g., "Best Selling eBook Directory"); selecting a book from the list in response to a request from the customer and displaying a portion of the content; and inputting predetermined items required to buy the book, comprising for instance payment information.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bookbrowse.com website in view of Barnes and Noble.com.

Bookbrowse shows displaying a list of books on a book recommendation home page; selecting a book from the list in response to a customer request and displaying a portion of the content. It does not explicitly show entering predetermined items required to buy the book. Barnes & Noble show entering information required to buy the book. It would have been obvious to one of ordinary skill in the art to modify the method of

Bookbrowse by entering required information to buy the book as taught by Barnes and Noble in order to allow purchasing of the book.

As to claim 5, it is noted that Bookbrowse in view of Barnes and Noble show all elements of the claim.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bookbrowse in view of Barnes and Noble as applied to claim 1 above, and further in view of Garrido (6,213,703).

As to claim 4, Bookbrowse in view of Barnes and Noble show that the step of inputting predetermined items includes going to a home page of book vendor that is linked to the recommendation home page. It does not show that the book vendor is a printing vendor. Garrido shows that the book vendor is a printing vendor (e.g., col. 6, line 63 – col. 7, line 12). It would have been obvious to one of ordinary skill in the art to further modify the method of Bookbrowse as taught by Garrido in order to facilitate for the sales and recommendation of low volume books that would not be feasible to publish otherwise.

Claims 2 and 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Bookbrowse in view of Barnes and Noble as applied to claim 1 above, and further in view of Hartrick et al (5,532,920).

Bookbrowse in view of Barnes and Noble show all elements except displaying the entire content of the book. Hartrick et al show providing the entire content of the

book for viewing. It would have been obvious to one of ordinary skill in the art to further modify the method of Bookbrowse by providing the entire content in order to aid the reader in determining whether to purchase a copy of the book.

Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebookstand.

As to claims 2 and 3, Ebookstand shows all elements of the claim except providing over half or all of the text of the book for display. However, it would have been an obvious matter of design choice to provide over half or all of the text for display since the specification does not show that the amount of text provided for preview solves any particular problem, or that the particular amount is provided for a specific reason, and it appears that the invention would function equally well with the amount shown in Ebookstand or the amounts claimed.

As to claim 5, Ebookstand shows all elements of the claim except requiring the buyer's name, address and payment information. However, it is notoriously old and well known in the art to require this information. It would have been obvious to one of ordinary skill in the art to modify the method of Ebookstand by requiring this information in order receive payment and track customers.

Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebookstand in view of Hartrick et al.

As to claims 2 and 3, Ebookstand shows all elements of the claim except providing all of the text of the book for display. Hartrick et al show providing all of the text for display. It would have been obvious to one of ordinary skill in the art to modify the method of Ebookstand by providing all text for display in order to aid the reader in determining whether to purchase a copy of the book.

As to claim 5, Ebookstand shows all elements of the claim except requiring the buyer's name, address and payment information. Hartrick shows requiring the information. It would have been obvious to one of ordinary skill in the art to modify the method of Ebookstand by requiring the specific information in order to charge customers and track customers.

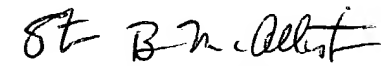
### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven B. McAllister